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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/767,661	01/29/2004	Michael Svilar	10761.1467	5386
81331 7590 04/14/2009 Accenture/Finnegan, Henderson, Farabow, Garrett & Dunner, LLP 901 New York Avenue Washington, DC 20001-4413				
EXAMINER				
MCPhillip, Adrian J				
ART UNIT		PAPER NUMBER		
3623				
MAIL DATE		DELIVERY MODE		
04/14/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/767,661

Applicant(s)

SVILAR ET AL.

Examiner

Adrian J. McPhillip

Art Unit

3623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 4, 7, 9-11, 13, 16, 19 and 21-23 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 4, 7, 9-11, 13, 16, 19 and 21-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Final Drawing Review (PTO-849)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This Non-Final Office Action is in response to Applicant's communication filed on December 5, 2008. Claims 1 and 13 have been amended. Claims 2-3, 5-6, 8, 12, 14-15, 17-18, 20, and 24 have been cancelled. Currently claims 1, 4, 7, 9-11, 13, 16, 19, and 21-23 remain pending.

Response to Amendment

2. Applicant's amendments to claims 1 and 13 are hereby acknowledged.

Response to Arguments

3. Applicant's arguments filed on July 31, 2008 have been fully considered, but are not persuasive. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., executing a what-if scenario by enabling a user to make a change in planned spending on the at least one marketing element and using econometric modeling to quantify the effect of the change in planned spending on consumer demand and shipments; modifying the at least one marketing plan based on the results of the what-if scenario to generate a modified marketing plan; executing the modified marketing plan and capturing actual consumer demand and shipment data; displaying both (i) the forecasted consumer demand, the actual consumer demand, and a first percent error between the forecasted consumer demand and the actual consumer demand; and (ii) the forecasted shipments, the actual shipments, and a second percent

error between the forecasted shipments and the actual shipments) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Furthermore these arguments are now moot in view of the newly presented grounds of rejection.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1, 4, 7 and 9-11 are rejected under 35 U.S.C. 101 as being directed towards non-statutory subject matter based on Supreme Court precedent, and recent Federal Circuit decisions, *In re Bilski* U.S. Court of Appeals Federal Circuit 88 USPQ2d 1385. The machine-or-transformation test is a two-branched inquiry; an applicant may show that a process claim satisfies § 101 either by showing that his claim is tied to a particular machine, or by showing that his claim transforms an article. See *Benson*, 409 U.S. at 70. Certain considerations are applicable to analysis under either branch. First, as illustrated by *Benson* and discussed below, the use of a specific machine or transformation of an article must impose meaningful limits on the claim's scope to impart patent-eligibility. See *Benson*, 409 U.S. at 71-72. Second, the involvement of the machine or transformation in the claimed process must not merely be insignificant extra-solution activity. See *Flook*, 437 U.S. at 590.
6. The methods recited in claims 1, 4, 7 and 9-11 are neither tied to a machine nor do they transform the underlying subject matter to a different state or thing. See *Diamond v. Diehr*, 450

U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); and *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972).

7. A method/process claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter. Here claims 1, 4, 7 and 9-11 fail to meet the above requirements because they are not tied to a particular machine. Since the Applicant's method steps fail the first prong of the new Federal Circuit decision, as they are not tied to another statutory class and can be preformed without the use of a particular apparatus, claims 1, 4, 7 and 9-11 are non-statutory.

8. When amending claims 1, 4, 7 and 9-11, Applicant is reminded that nominal recitations of structure in an otherwise ineligible method fail to make the method a statutory process. See *Benson*, 409 U.S. at 71-72. As *Comiskey* recognized, "the mere use of the machine to collect data necessary for application of the mental process may not make the claim patentable subject matter." *Comiskey*, 499 F.3d at 1380 (citing *In re Grams*, 888 F.2d 835, 839-40 (Fed. Cir.1989)). Incidental physical limitations, such as data gathering, field of use limitations, and post-solution activity are not enough to convert an abstract idea into a statutory process. In other words, nominal or token recitations of structure in a method claim do not convert an otherwise ineligible claim into an eligible one.

9. Claims 13, 16, 19, and 21-23 are rejected under 35 U.S.C. 101 as being directed towards non-statutory subject matter. Claims 13, 16, 19, and 21-23 are directed toward functional descriptive material, specifically: a system comprising various modules. The claims do not positively recite elements that necessarily constitute a system or apparatus, and further do not positively tie the method steps being performed to any specific structure or apparatus. Rather,

the claims could be directed to software. Software per se is not patentable under § 101; therefore, the claimed invention does not fall within a statutory class of patentable subject matter.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

12. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schroeder et al. (US 2003/0130883) – hereinafter Schroeder.

13. Regarding **claim 1 and 13**, Schroeder discloses a method and system for using econometric techniques to quantify marketing drivers and forecast consumer demand and shipments comprising:

- providing at least one marketing plan, wherein the at least one marketing plan comprises at least one marketing element (see paragraphs 57-58 and fig 1 wherein proposed promotions/marketing plans are entered into the modeling system);

- using econometric modeling to quantify the effect of the at least one marketing element on shipments (see paragraph 50 wherein the predicted effects of the promotion in question are determined and include an analysis of expected ship quantities. Furthermore paragraph 39 discloses using regression as a method of analyzing the data in question);
- forecasting consumer demand and shipments in response to the at least one marketing plan and results of the econometric modeling (see paragraph 73 wherein the business planner builds shipment estimates and predicts supply chain demand related to the implementation of a particular promotion);
- executing a what-if scenario by enabling a user to make a change in planned spending on the at least one marketing element and using econometric modeling to quantify the effect of the change in planned spending on consumer demand and shipments (see paragraph 29 where planned spending regarding promotional activities are entered into the system. Paragraphs 59-68 then disclose a lift model that details the effects/lift of various promotions, which includes calculating sales and profit figures based on consumer demand and shipping information. Users may then tweak various aspects of the promotion in order to forecast and compare the effects of the different promotions being considered.);
- modifying the at least one marketing plan based on the results of the what-if scenario to generate a modified marketing plan (see paragraph 59 wherein if the predicted results are in alignment, then the promotion may proceed to completion. If the

- predicted results are not in alignment, then a decision is made whether to modify the promotion plans or operation plans);
- executing the modified marketing plan and capturing actual consumer demand and shipment data (see paragraph 59 wherein the modified plan is implemented and paragraph 102 wherein an embodiment of the invention captures actual demand and shipment data. Additionally claim 35 captures shipping volume to market data and uses it to estimate sales);
 - displaying predictions pertaining to the planned promotion (see claim 43) and utilizing actual sales data to repeatedly refine the prediction model by comparing predicted data with actual data to maximize the model's utility and minimize future errors (see paragraph 78).

Schroeder does not explicitly disclose displaying both (i) the forecasted consumer demand, the actual consumer demand, and a first percent error between the forecasted consumer demand and the actual consumer demand; and (ii) the forecasted shipments, the actual shipments, and a second percent error between the forecasted shipments and the actual shipments.

The examiner hereby takes official notice that it was well known to those of ordinary skill in the art, at the time of the invention, to calculate and display percent errors between forecasted data and actual data when evaluating the predictive capacity of a particular model. Schroeder in fact discloses the comparison of forecasted and actual data but does not explicitly calculate percentages between the two. It was however, well known at the time of the invention to calculate the percentage difference between actual and forecasted data, for example in quality control environments.

Following KSR, the Supreme Court issued several rationales for supporting a conclusion that a claim would have been obvious. If a particular known technique was recognized as part of the ordinary capabilities of one skilled in the art, and one of ordinary skill in the art would have been capable of applying this known technique to a known device (method, or product) and the results would have been predictable to one of ordinary skill in the art; then the claim will be deemed obvious in view of the prior art.

Applicant is applying a known technique, in this case calculating and displaying percent errors between forecasted data and actual data, to a known device, in this case to forecasted and actual consumer demand as well as forecasted and actual shipments, both of which are known elements disclosed by Schroeder, and is generating a predictable result. It would have been obvious, to one of ordinary skill in the art, that the result of applying the aforementioned technique would be a method for generating a predictive model that displayed the forecasted consumer demand, the actual consumer demand, and a first percent error between the forecasted consumer demand and the actual consumer demand as well as the forecasted shipments, the actual shipments, and a second percent error between the forecasted shipments and the actual shipments. Therefore since the Applicant is claiming the application of a known technique to a known device to yield a predictable result, the claim is deemed obvious in view of the prior art.

14. Regarding **claims 4 and 16**, Schroeder discloses a method and system to quantify marketing drivers and forecast at least one of consumer demand and shipments further comprising calculating a lift parameter of the at least one marketing element (see fig 1 and 2 wherein a lift model calculates the predicted lift that should result from a particular promotion and also paragraph 58).

15. Regarding **claims 7 and 19**, Schroeder discloses a method and system to quantify marketing drivers and forecast at least one of consumer demand and shipments wherein the at least one marketing element comprises at least one of promotions, advertising, points of distribution and product changes (see figs 1-2 and paragraphs 18-28 wherein the marketing element being analyzed is disclosed to be a promotion).

16. Claims 9-11 and 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schroeder US 20030130883 A1 in view of Cox et al. (US 20020143604 A1) – hereinafter Cox.

17. Regarding **claims 9 and 21**, and **21-23**, Schroeder discloses a method and system to quantify marketing drivers and forecast at least one of consumer demand and shipments but fails to explicitly teach tracking the reasons for the forecast errors along with the forecast errors themselves.

Cox, however, discloses tracking the accuracy of a predictive model to assess its effectiveness as well as refining model assumptions (see paragraph 128), which are the reasons for the solution that the predictive model comes to. Therefore Cox effectively discloses tracking the errors, in the form of the differences between the predicted and actual values, as well as tracking and eventually refining the reasons for the errors, in the form of the assumptions used by the model to arrive at its predictions.

It would have been obvious to one of ordinary skill in the art, at the time of the invention, to modify the method of Schroeder to include tracking the reasons for the forecast errors along with the forecast errors themselves in order to increase the accuracy of future predictions and enhance the effectiveness of the overall model. Since both references are interested in accurately

forecasting demand and since the modification could have been performed readily and easily by one of ordinary skill in the art, with neither undue experimentation nor risk of unexpected results, a rejection under 35 U.S.C 103(a) is appropriate.

Conclusion

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adrian J. McPhillip whose telephone number is (571)270-5399. The examiner can normally be reached on Monday to Thursday 7:30 - 5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Beth Boswell can be reached on (571)272-6737. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/A. J. M./
Examiner, Art Unit 3623

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/Beth V. Boswell/

Supervisory Patent Examiner, Art Unit 3623